

REMARKS

Status of the Claims

Claims 1-14 are pending in this application. No claims have been canceled, added or amended. Applicants submit the following arguments in support of the allowability of the claims. Applicants respectfully request entry of this Reply as no new issues have been raised.

Rejection under 35 USC 103(a)

The Examiner maintains the rejection of claims 1-14 as obvious over Ito et al. USP 6,150,084 (Ito '084) in view of JP 11-149136 (JP '136) or Adin et al. USP 6,054,260 (Adin '260). Applicants traverse the rejection and respectfully request the withdrawal thereof.

Ito '084 discloses a photothermographic material containing the compounds of formulas (1) to (3). However, Ito '084 fails to disclose the compound of formula (I). The Examiner relies on JP '136 and Adin '260 for disclosing a compound of formula I. Applicants submit that Yamada US Patent 6,177,240 is substantially an English equivalent to JP '136. Therefore, Applicants refer to Yamada '240 instead of JP '136 in the following arguments.

Yamada '240 discloses a thermographic recording element containing a compound of formula (I) as a nucleating agent. Yamada '240 further discloses that hydrazines, acrylonitriles and other

nucleating agents can be used in combination with the compound of formula (I). See column 26, line 41 to column 27, line 26. However, Yamada '240 fails to disclose an example using the compound of formula (I) in combination with a compound of formulas (1) to (3).

Adin '260 discloses a silver halide photothermographic element containing a compound of formula (I). However, Adin '260 fails to disclose a compound of formulas (1) to (3). Moreover, Adin '260 fails to disclose the combination of formula (I) and a compound of formulas (1) to (3).

Inasmuch as the combination of the cited references fails to disclose or suggest the combination of a compound of formula (I) with a compound of formulas (1) to (3), no *prima facie* case of obviousness has been established. The Examiner states in the Office Action at the paragraph bridging pages 3 and 4 of the Office Action that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the compound taught in JP '136 (Yamada '240) to produce a photothermographic material with high Dmax and sensitivity, enhanced contrast, small variation in photographic performance due to fluctuation of development conditions and having a superior effect of restraining dependence on development conditions. The Examiner also states that it would have been obvious to use the compound taught in Adin '260 in the material taught in Ito '084 to enhance both intrinsic

spectrally sensitivity of the silver halide emulsion to arrive at the present invention.

Applicants respectfully disagree with the Examiner's statements. The combination of references fails to disclose the combination of formula I and a compound of formulas (1) to (3). Furthermore, the objective of the present invention are not met by the combination of cited references.

The objective of the present invention as stated in the specification at the paragraph bridging pages 3 to 4 is to provide a photothermographic material that shows low fog and high Dmax (maximum density), having photographic characteristics of high sensitivity and high contrast, and showing little increase of fog even if the material is stored for a long period of time after development. This invention is useful in all photothermographic material, in particular, for photographic art, particularly, for scanners and image setters. Applicant submits that the combination of reference fails to disclose or suggest this objective of minimizing fog even after long term storage after development.

Applicants submit that this advantage of minimized fog after long term storage after development of the film is a significant objective of the present invention. One of ordinary skill in the art would not be motivated to use the compound of formula (I) in combination with the compound of formula (1) to (3) to achieve this minimization of an increase in fog after long term storage.

compound of formula (I) in combination with the compound of formula (1) to (3) to achieve this minimization of an increase in fog after long term storage.

Applicants further submit that the Examiner is using impermissible hindsight to reconstruct the present invention. The Examiner merely relies on Applicants' own teachings to form the obviousness rejection. The Examiner has taken the present invention and divided it into parts. The Examiner has attempted to find the combination of a compound of formula (I) and a compound of formulas (1) to (3) in separate references. However, none of the references suggests the combination of the compounds for lowering fog after long term storage as in the present invention. This type of hindsight reconstruction is impermissible according to MPEP 2141 and In re Deminski, 796 F.2d 436, 443 230 USPQ 313, 316 (Fed. Cir. 1986).

Since there is no suggestion or teaching to combine the references to obtain the present invention of using the compound of formula (I) in combination with the compound of formula (1) to (3) to achieve minimized fog after long storage, no *prima facie* case of obviousness has been established. One of ordinary skill in the art would not make the suggested combination to produce the photothermographic material of the present invention that has little increase in fog after long storage and achieve this novel advantageous effect. The advantageous effects of the present

invention are described and demonstrated by the data in Table 13 of the present specification.

In addition to the above-described novel advantageous effects, the photothermographic material of the present invention exhibits remarkable sensitivity. Please see the data in Table 13. Compared to the standard sample (Sample 1-1), Sample 1-2, which contains a compound of formula (I), increases sensitivity by 0.10 and Sample 1-3 containing a compound of formula (1) to (3) increases sensitivity by 0.50. One of ordinary skill in the art would reasonably predict that Sample 1-7, containing the compound of formula (I) and the compound of formula (1) to (3), would increase sensitivity by 0.60. However, Sample 1-7 actually increases sensitivity by 0.80. One of ordinary skill in the art would not be able to predict this synergic effect from the simple disclosures in the cited references.

For the foregoing reasons, Applicants respectfully request that the rejection be withdrawn as no *prima facie* case of obviousness has been established.

### Conclusion

As Applicants have addressed and overcome all rejections in the Office Action, Applicants respectfully request that the rejections be withdrawn and that the claims be allowed.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a three (3) month extension of time for filing a reply in connection with the present application, and the required fee of \$950.00 is attached to the Notice of Appeal filed concurrently herewith.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kecia Reynolds (Reg. No. 47,021) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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